IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: UNEO=12

In re Application of:	)	Confirmation No.: 6639
Takashi UNEO	)	Art Unit: 1636
Appln. No.: 10/569,814 PCT/JP04/12172	)	Examiner: C. S. HIBBERT
Filing Date: August 25, 2004 371(c) Date: February 28, 2006	)	June 30, 2008 **MONDAY**
For: METHOD OF SEARCHING FOR FUNCTIONAL NUCLEOTIDE MOLECULE	)	

REPLY TO RESTRICTION AND ELECTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building, 401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants are in receipt of the Office Action mailed May 28, 2008, in the nature of restriction and election of species requirements purportedly on the basis of lack of unity of invention. Applicants reply below.

First, however, applicants request that the PTO acknowledge receipt of applicants' papers filed under Section 119.

Restriction has first been required among what the PTO deems as being eight (8) separate inventions. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group III, including claims 7 and 10 (requiring consideration of claims 1 and 5), with traverse and without prejudice.

It is respectfully submitted that the prior art relied upon to allegedly destroy unity of invention does not do so, and that the generic nature of the invention which extends through all the claims forms a single general inventive concept under PCT Rule 13.1 because of the same or corresponding special technical feature or features in those claims, in accordance with PCT Rule 13.2. Even if the broader generic concept were not patentable, and such is not admitted, there would still be a narrower single general inventive concept throughout the claims under PCT Rules 13.1 and 13.2.

Accordingly, applicants respectfully request withdrawal of the holding of lack of unity of invention.

In addition to the aforementioned restriction requirement, the PTO has also imposed a series of election of species requirements if applicants have elected Group III,

which they have. Again, as applicants must make an election even when the requirement is traversed, applicants hereby respectfully and provisionally elect, with traverse and without prejudice, the following species:

> "a nucleotide sequence that encodes a protein or a part of the protein" (as claim 1 (1));
>
> "the non-translatable nucleotide sequence is located downstream of the protein-encoding nucleotide sequence linked to the promoter sequence in a translatable state" (as claim 2);
>
> "cell"; and
>
> "a nucleotide sequence that encodes a protein in a target gene".

Applicants do not deny that the species may indeed be patentably distinct from one another. However, it cannot at this stage be properly said that the election of species is properly based on lack of unity of invention under PCT Rules 13.1 and 13.2, because the generic claims clearly establish that the species are linked to form a single general inventive concept under PCT Rules 13.1 and 13.2 as called for in the generic claims.

Accordingly, applicants believe that the election of species requirements are incorrect and therefore respectfully request that they be withdrawn.

Applicants now respectfully await the results of an examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By
Sheridan Neimark
Registration No. 20,520

SN:jnj

Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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